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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,106	03/16/2004	Bran Ferren	1103-007-001-000000	3221
71/484	7/5/09	11/30/2009		
IV - SUITER SWANTZ PC LLO 14301 FNB PARKWAY , SUITE 220 OMAHA, NE 68154				
EXAMINER				
FRANKLIN, JAMARA ALZAIDA				
ART UNIT		PAPER NUMBER		
2876				
MAIL DATE		DELIVERY MODE		
11/30/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,106

Applicant(s)

FERREN ET AL.

Examiner

JAMARA A. FRANKLIN

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/07/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement is made of the amendment and response filed on 7/07/09. Claims 1-48 are currently pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9, 13, 15, 18, and 22-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796) (hereinafter referred to as ‘Wallace’).

Wallace teaches

an item comprising:

an outer part (member 3) including at least one outer material (plastic 20 mils thick) (col. 2, lines 63-64); and

an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of:

(1) a substantially empty cavity in the at least one outer material, or

(2) at least one identifying material (magnetic ink paste 9) filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light;

the item wherein the at least one outer material is transmissive to RF radiation (see figure 4);

the item wherein the item is produced by rapid prototyping;

the item wherein the identifier identifies the item as a member of a set of similar items (col. 3, lines 12-14);

the item wherein the identifier identifies the item uniquely (col. 3, lines 12-14);

a method of identifying an item comprising:

detecting an at least one three-dimensional configuration with a penetrating imaging tool, the detecting an at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool; and

reading identifying information by interpreting the output;

the method wherein the detecting an at least one three-dimensional configuration with a penetrating imaging tool includes:

detecting an at least one three-dimensional configuration with a magnetic-resonance imager;

the method wherein the reading identifying information by interpreting the output includes:

reading identifying information from at least one identifying material emitting identifying electromagnetic radiation when irradiated with specified electromagnetic radiation;

the method wherein the reading identifying information from at least one identifying material includes:

reading identifying information from a security tag;

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-12 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace in view of Dunlap et al. (US 2005/0068182) (hereinafter referred to as 'Dunlap').

The teachings of Wallace have been discussed above.

Wallace lacks the teaching of identifying material comprising a re-radiating antenna and the identifying material comprising a radio-frequency identification device.

Dunlap teaches an item comprising:

identifying material comprising a re-radiating antenna and the identifying material comprising a radio-frequency identification device (paragraph 26).

One of ordinary skill in the art would have readily recognized that providing the Wallace invention with a re-radiating antenna and radio-frequency identification device would have been beneficial since a re-radiating antenna or radio-frequency identification device could provide larger available memory for storage of information and communication of such information in a

relative small physical space. Therefore it would have been obvious at the time the invention was made to modify the teachings of Wallace with the aforementioned teaching of Dunlap.

5. Claims 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace in view of McEwan (US 7,609,290).

The teachings of Wallace have been discussed above.

Wallace lacks the teaching of detecting the configuration using various imagers.

McEwan teaches a method wherein detecting an at least one configuration with a penetrating imaging tool includes:

detecting a configuration with an x-ray imager (col. 6, lines 1-6);

detecting a configuration with an acoustic imager (col. 6, lines 1-6);

emitting acoustic energy and detecting an acoustic signature in response to the emitted acoustic energy (col. 6, lines 1-6).

One of ordinary skill in the art would have readily recognized that providing the Wallace invention with the various imagers as discussed in the McEwan invention would have been beneficial since either an x-ray imager or an acoustic imager could perform the necessary function of reading pertinent information in a time- and cost-effective manner, thereby supporting an optimally functional system. Therefore it would have been obvious at the time the invention was made to modify the teachings of Wallace with the aforementioned teaching of McEwan.

Response to Arguments

A new rejection has hereby been submitted using the Wallace (US 3,860,796) reference which had previously been used in a rejection of the office action of paper no. 20080131 but had not been argued by the examiner.

Regarding the argument filed on 5/12/08 against the Wallace reference, the examiner submits that the Wallace invention does indeed teach "at least one outer material that is substantially opaque to visible light" since the figures of the Wallace invention, namely figure 3, support indication that the card of the Wallace invention is opaque to visible light (i.e. not transparent).

Furthermore, the examiner submits that the Wallace invention does indeed teach "an identifier including at least one three-dimensional configuration corresponding to the identifier" since the magnetic ink paste 9 of the Wallace invention fills the cavity which is created in the card 3. The magnetic ink paste 9 as held within the cavity is in the form a three-dimensional configuration since the paste 9 has a depth, width, and height as contained by the cavity. The magnetic ink paste 9 is used to encoded identifying information identifying the issuer of the card and the card holder (col. 3, lines 12-14).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARA A. FRANKLIN whose telephone number is (571)272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/
Primary Examiner, Art Unit 2876

November 23, 2009
JAF